

REMARKS

The application has been amended and is believed to be in condition for allowance.

Some of the previous claims have been amended. New claims have been added.

Claims 1-10 were rejected under section 112, 2<sup>nd</sup> paragraph, as indefinite.

These claims have been amended to remedy the stated bases of rejection. Withdrawal of this rejection is therefore solicited.

Claims 1-3 were rejected as obvious over STEFANI 5,477,781 in view of KOHLER 5,378,503 and PANKAKE 5,743,964.

Claims 4-10 are rejected in further view of REEVE et al. 3,693,585.

Applicant respectfully disagrees.

STEFANI is said to teach a rotary machine for decoration of ceramic tiles. STEFANI is acknowledged not to teach the two recited slides to support the cylinder and doctor, and implicitly acknowledged not to teach the elements relating thereto.

KOHLER is offered as teaching "an improved doctor assembly" having two slides.

PANKAKE is offered as teaching that it is typical to mount the cylinder onto different slides.

Applicant respectfully disagrees. As stated by MPEP §706.02(j), to establish a *prima facie* case of obviousness the Official Action must first, consider the relevant teachings of the prior art, and after determining the differences between the pending claim and the prior art teachings, second, propose modifications of the prior art necessary to arrive at the claimed subject matter, explaining the motivation for combining the particular references and making the proposed modifications to those references. Thus, there must be motivation to modify the references and a teaching or suggestion of all the claim recitations.

However, the present disclosure itself cannot be used to render the claimed invention obvious. The Federal Circuit emphasized in July, 1998 that "[m]ost, if not all, inventions are combinations and mostly of old elements." *In re Rouffett*, 47 USPQ 2d 1453, 1457 citing to *Richdel, Inc. v. Sunspool Corp.*, 219 USPQ 8, 12 (Fed. Cir. 1983). The Federal Circuit continued by noting that "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blue print for piecing together elements in the prior art to defeat the patentability of the claimed invention."

Thus, the Federal Circuit requires that in order to prevent the use of such hindsight, the Official Action must "show reasons that the skilled artisan, confronted with the same

problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (*In re Rouffett* at 1458).

The examination must include consideration of how the applied references operate and whether one of skill, before the fact and not *ex post*, would or would not have been motivated to modify the prior art in view of the current teachings and understandings of the prior art.

In this regard, it is also well established that in addition to the teaching or suggestion to make the claimed combination, there must be a reasonable expectation of success in making the modified combination (that expectation of success being found in the prior art, and not be based on the present disclosure). *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further, the prior art references must either expressly or impliedly suggest the claimed invention or the Official Action must convincingly reason why one of skill in the art would have found the claimed invention obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

In the present situation, there is no teaching or suggestion available to provide the requisite motivation, suggest the necessary modifications, or provide the reasonable

expectation of success. Thus, the obviousness rejection is not believed to be viable.

KOHLER

Reference is made to Figure 2 and column 4, lines 22-64 where one can clearly see that the various parts (organs) used to adjust the doctor 17 are mechanically completely independent of one another.

The frame 19 is rotated about the axis 21 (perpendicular to the plane of the drawing in Figure 2 and identified by the active edge 18 of the coater blade 17) by its own servo actuator 33.

The adjusting assembly 23, which regulates the pressure exerted by the coater blade 17 on the web 10 comprises a frame which is mobile with respect to the frame 19 in a direction indicated by the arrow 26 (Y) (see column 4 starting at line 30) and a second slide 28 constrained to the first slide 24 and mobile with respect thereto in the direction indicated by the arrow 29 (X) which is perpendicular to the direction of the arrow 26 (Y) (see column 4, lines 43-45).

The first slide 24 is commanded to move in the direction indicated by the arrow 26 (Y) by its dedicated servo actuator 36, the second slide 28 is commanded to move in the direction indicated by the arrow 29 (X) by its dedicated servo actuator 37.

The servo actuator 36 and the servo actuator 37 have no physical connection to one another; one is fixed to the frame 19, and the other is fixed to the first slide 24.

Unlike KOHLER, applicant's device is not limited to performing whatever adjustment of the doctor, but also connects in a single mechanism, supported by the maneuvering screw 6, the adjustment of the doctor 5 with respect to the matrix-bearing cylinder 3, and the height adjustment of the matrix-bearing cylinder 3 with respect to the mobile rest plane 16.

See that claim 1 recites the first slide constrained on the vertically-developing frame and slidable vertically with respect thereto; the matrix cylinder supported on the first slide; the second slide constrained on the vertically-developing frame and sliding vertically with respect thereto; the doctor supported on the second slide; and means for relatively positioning the first slide and the second slide relative to the vertically-developing frame. Claim 11 includes recitations to these features, specifically reciting the maneuvering screw. See that claim 2 recites the maneuvering screw. See also Figure 1.

There is no motivation to re-engineer either STEFANI or KOHLER to result in this recited configuration.

Claim 2 further recites a maneuvering screw having a vertical axis, on which maneuvering screw are coupled a first nut, which is solidly constrained to the first slide, and a second nut, which is solidly constrained in translation along the

vertical axis to the second slide and which is mobile in rotation about the vertical axis with respect to the second slide (4), which vertical axis is also a rotation axis of the second nut and the first nut. Claim 12 is similar.

Thus, both the first nut 7 and the second nut 8 are coupled on the sole maneuvering screw 6 and are independently, controllably displaceable along the same vertical direction to control displacements of the first and second slides along the same direction.

See that claim 3 recites that the maneuvering screw performs rotations by a first step motor and that the second nut performs rotations with respect to the second slide by a second step motor which is solidly constrained to the second slide. See also claim 13.

The first nut 7 is commanded to translate in both directions (up and down), directly by the rotation of the maneuvering screw 6, driven by the first step motor 9. The independence of the movements is obtained by the second step motor 11 which acts on the second nut 8, free to rotate with respect to the second slide 4 but solid in translation there-with along the axis of the maneuvering screw 6.

Claims 14-16 also relate to these features.

Nothing of this is taught by KOHLER and its inclusion into any modification of STEFANI would be impermissible hindsight obtained from the present application's disclosure.

PANKAKE teaches a system for application of a covering on a steel sheet by the use of rollers. Two rollers are placed on slides and moved by linear motors to regulate the pressure between the cylinders. A sensor measures the compression force.

From this, there is nothing in common with the recited invention or to suggest modification to the STEFANI-KOHLER combination that would result in the recited invention. There are only slides for realizing movements and a slide device for adjusting the pressure.

REEVE et al. leads to the same conclusion as there is nothing seen that teaches or suggests the features of the present invention as recited in the pending claims.

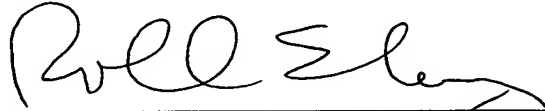
In view of the above, it is believed clear that any proper combination of these references would not result in the recited invention. Therefore, reconsideration and allowance of all the claims are respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



---

Roland E. Long, Jr. Reg. No. 41,949  
745 South 23<sup>rd</sup> Street  
Arlington, VA 22202  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

REL/lrs